

## **RESPONSE TO DETAILED ACTION**

Applicant has reviewed the entire detailed action and is responding so that a Notice of Allowance can be issued for the allowable subject matter indicated on pages 6 and 7 of the Detailed Action issued on April 7, 2011. All issues raised by the examiner regarding 35 USC 112 and 101 have been addressed and appropriate corrections have been made.

### ***Specification***

Applicant understands the examiner's issue with new matter in the specification and has amended the claims such that "computer readable medium" is no longer claimed and the use of the term "client-server engine" which is used and described in claims 23-33 is no longer used, as the term "engine" has been omitted from the claims. The term client-server is an abbreviated version of what is termed as a client computer and a server computer and this abbreviation is commonly understood as such by anyone skilled in the art and can be found throughout the original application as well as in Figure 5. No amended specification is therefore necessary.

### ***Claim Objections***

Claims 23-33 are have been amended to remove the words "wherein"; "whereby" and "configured to" which were objected to by the examiner – they have been eliminated and therefore any issues regarding the lack of merit or weight given to such clauses has also been obviated. Instead, claims 23-33 have been provided with substitute language where appropriate, including "such that" in lieu of "wherein" or "whereby".

### ***Claim Rejections - 35 USC § 112***

Applicant has provided an amended set of claims to obviate the issue regarding the terms "computer readable medium" and "client-server engine system" as stated above. These terms are no longer used.

Applicant has also amended claims 23-33 to more precisely describe the claimed system and distinguished “system” from “method”.

Claims 31-33 no longer contain language that is not supported by the original specification.

Claim 24 has been amended to remove the word “itself”:

Claim 31 has been amended to remove the word “they”.

Hence, claims 24 and 31 no longer provide any ambiguous meaning and now more precisely describe the invention. These rejections have been obviated.

Applicant is confused by examiner’s statement (5) regarding “evaluation methods”. Applicant describes specific valuation methods rather than “evaluation methods”. These valuation methods include Black-Sholes pricing theory, Technology Risk/Reward Units and Discounted Cash Flow models for valuing intellectual property. This is fully described both in the body of the original specification and in claims 23-33. The only place where the word “evaluation” was used in was in new claim 31, and in this case the word “evaluation” has been stricken in the currently amended claim 31.

Applicant is again confused by the Examiner’s statement that she is unclear by the claimed combination in claim 26, but has nonetheless amended the claim to more precisely define the elements which comprise the combination. The combination *of techniques* is what is referred to and these techniques are explained as; the combination of intelligent searching for (a technique), problem solving with (a technique ), and valuation of intellectual property (a technique).

Applicant has amended claim 23 and removed the word “optionally”

Applicant has amended claims 24-29 and reworded the claims so that the words simultaneously, determination, manner, valuation, and matching are either more clearly defined or eliminated.

Respectfully, these words, as used in the currently amended claims are not at all ambiguous or confusing, as they are precisely defined in the Miriam-Webster.com's dictionary (and used herein with the same meaning) as follows:

Simultaneously; “existing or occurring at the same time : exactly coincident

Determination; “the resolving of a question by argument or reasoning

Manner - the word manner has been stricken from the amended claims to remove any possible ambiguity.

Valuation; “the act or process of valuing; *specifically* : appraisal of property or the estimated or determined market value of a thing

Matching; “to put in a set possessing equal or harmonizing attributes”

Instantaneous “done, occurring, or acting without any perceptible duration of time or done without any delay being purposely or occurring or present at a particular instant

These terms in the claims are used in the exact manner as defined in Webster-Meriam's dictionary and as such, the Examiner is requested to remove the objections to these terms on the basis she considers that the terms are “unclear”.

There is no claim 17, and as such the words “instantaneous fashion” are not an issue in the present application and in this response and the Examiner is requested to remove this objection. The word “fashion” has been stricken from any of the amended claims provided herewith.

Claim 31 has been amended to more precisely define the instantaneous and simultaneous aspects of the claimed system.

Claims 31-33 have been amended to remove the wording “meaningful manner” to more precisely define the claimed invention.

Claim 31 has been amended to remove the word “instant” from the word “valuation”.

Claim 23 has been amended to properly provide antecedent basis for the method and subsequent “valuation methods”.

Claims 31-33 have been amended to ensure there is no missing step regarding “generating an electronic shoe”. The generation of an electronic patent shoe from the computer processor’s manipulation of the software provides a storage device and repository for patents that are subsequently valued by the valuation methods described and the shoe is necessary for assisting with implementing the claimed system.

Additionally, applicant has reviewed all the claims for accuracy and completeness according to the examiner’s request, and as amended these claims now completely and precisely define the claimed invention.

Applicant has also amended claims 31-33 to ensure that they no longer “recite purely mental steps” as the Examiner so states. The sequential steps required to achieve the system claimed includes the use of a computer processor which is a machine that will process software that requires the steps be used as a set of instructions to be carried as listed in claims 31-33 by taking data input in an initial and mostly unusable form and providing transformed data output that has utility and value. Tying the machine and associated software has been further defined in the newly amended claims. The material that has been changed to a different state is the data input which has been changed to data output that is usable as a map or report or both.

The words “enabling” , “providing access to”, “performing pursuant to a command”, “generating a solution”..... in this instant, provides very tangible, concrete results including generating maps and reports that value IP in a specific technology sector. It is inconceivable to the applicant how these action verbs that require an active step would be viewed as not leading to a tangible result when the claims end in the phrases...”providing reports or to provide reports”. These reports are tangible results that occur from the active steps and are the result of translating input data into output that is useful and concise and has utility for anyone skilled in the art associated with understanding and valuing the IP. These reports supply utility to the claimed inventions – they are in fact, the result of transforming the data without using the term

“transforming the data” which is inherent in what is performed by any computer processor and as is described in the claims and supporting specification.

More specifically as defined at [www.Wikipedia.com](http://www.Wikipedia.com) , “A microprocessor incorporates the functions of a computer's central processing unit (CPU) on a single integrated circuit (IC, or microchip).<sup>[1]</sup> It is a multipurpose, programmable, clock-driven, register-based electronic device that accepts digital data as input, processes it according to instructions stored in its memory, and provides results as output”. The words “microprocessor” and “computer processor” are synonymous terms used in the IT industry. Applicant worked for IBM for 13 years before applying for this application and is familiar with and uses these terms frequently and interchangeably. It is clear that the functions carried out by the computer processor of the present application are that it accepts data and processes it according to instructions provided in the claims – this is the transformation.

In the specification and associated claims, it is clear that, additionally, the applicant utilizes a client-server computer (hardware) system. By definition, at [www.Wikipedia.com](http://www.Wikipedia.com); “The *client-server* characteristic describes the relationship of cooperating programs in an application. The **server component provides a function or service to one or many clients, which initiate requests for such services. Functions such as email exchange, web access and database access, are built on the client-server model.** As an example - Users accessing (banking services) from their computer use a web browser client to send a request to a web server (at a bank). That program may in turn forward the request to its own database client program that sends a request to a database server (at another bank) computer to retrieve the account information. The balance is returned (to the bank) database client, which in turn serves it back to the web browser client displaying the results to the user. The client-server model has become one of the central ideas of network computing. Many business applications being written today use the client-server model. So do the Internet's main application protocols, such as HTTP,SMTP, Telnet, and DNS.”

These functions (web and data base access – these are functions in our application) have utility in that they are used to generate reports and maps from the data – which in the present application is scientific and intellectual property (IP) data. How the Examiner can state that this provides no useful, tangible, or concrete result is beyond reasonable comprehension.

If the Examiner still fails to understand this and not accept these clear definitions, applicant is hereby requesting an in person interview with the Examiner and her SPE, Mr. Nick Corsaro, to resolve any further language ambiguities. Nonetheless, applicant has amended the claims through revisions that were suggested by the Examiner to accommodate the Examiner's interpretations and understandings so that the application can finally be allowed.

Applicant submits that the application is now in condition for allowance, and early notification of such action is earnestly solicited.

Please deduct any shortages of fees from the USPTO account for Customer #29439.

Dated this 8<sup>th</sup> day of August 2011

Respectfully Submitted,

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